

**SUPPORT FOR THE AMENDMENTS**

Support for new claims 32-35 can be found in original claims 1 and 31. No new matter would be added upon entry of this amendment.

Claims 2-30 and 32-35 will be pending upon entry of this amendment.

**REMARKS**

In the September 4, 1998 Official Action, claims 1 and 31 have rejected under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph, as being allegedly not useful for all of the purposes listed. According to the Examiner, many of the utilities are unlikely to be treatable and would require considerable proof. This rejection is obviated by the submission of new claims 32-35. The new claims recite separate methods of use for anxiety and depression. Accordingly, the method of use claims have been rewritten to limit each method of use claim to one method of use as requested by the Examiner. Withdrawal of the rejection of claims 1 and 31 under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph, rejection is respectfully requested. Withdrawal of the rejection of claims 2 and 3 as dependent on a rejected claim is also respectfully requested.

Applicants respectfully submit that cancellation of claims 1 and 31 does not limit or prejudice Applicants' right to claim the cancelled methods of use in later continuation or continuation-in-part applications based on the above-identified patent application.



In response to the Examiner's inquiry in the Official Action dated September 4, 1998, the purpose of the proviso statement at the end of claim 4 is to exclude compounds which are not part of the present invention. Proviso (1) excludes compounds which are disclosed in EP 0 269 859; however, the compounds of the cited reference cannot be properly modified for lack of the requisite motivation or a reasonable expectation of success to motivate a skilled artisan to prepare the compounds of the present invention. Proviso (2) excludes compounds which are disclosed in U.S. Patent No. 3,910,907; however, the compounds of the cited reference cannot be properly modified for lack of the requisite motivation or a reasonable expectation of success to motivate a skilled artisan to prepare the compounds of the present invention. Proviso (3) excludes compounds which are disclosed in U.S. Patent No. 3,995,039; however, the compounds of the cited reference cannot be properly modified for lack of the requisite motivation or a reasonable expectation of success to motivate a skilled artisan to prepare the compounds of the present invention. Proviso (4) excludes compounds which are disclosed in U.S. Patent No. 4,892,576; however, the compounds of the cited reference cannot be properly modified for lack of the requisite motivation or a reasonable expectation of success to motivate a skilled artisan to prepare the compounds of the present invention. Proviso (5) excludes compounds which are disclosed in U.S. Patent No. 5,484,760 and WO 92/10098; however, the compounds of the cited reference cannot be properly modified for lack of the requisite motivation or a

reasonable expectation of success to motivate a skilled artisan to prepare the compounds of the present invention. For the reasons set forth above, those of ordinary skill in the art would not have found it obvious to modify the compounds in the cited references so as to arrive at the claimed compounds of the present invention.

In the Official Action dated September 4, 1998, 4-29 have been rejected over the prior art. The rejection of claims 4 to 29 over the cited references is respectfully traversed. Applicants respectfully presume that claims 4-29 have been rejected under 35 U.S.C. §103; however, the Examiner has not provided specific information about the presumed 35 U.S.C. §103 rejection or the references under which the claims were rejected. Applicants respectfully request specific details of the presumed 35 U.S.C. §103 rejection, so that the rejection may be properly addressed.

As noted by the PTO Board of Appeals in Ex parte Wolters, 214 U.S.P.Q. 735 (P.T.O. B.P.A. I. 1979), the burden of establishing a prima facie case of obviousness falls upon the Examiner. In determining whether a case of prima facie obviousness exists, it is necessary to ascertain whether or not the disclosures of the cited prior art would make the claimed substitution, combination or other modification. In re Lalu, 223 U.S.P.Q. 1257 (Fed. Cir. 1984). In the Official Action September 4, 1998, the Examiner has not established a prima facie case of obviousness with regard to the references cited at pages 4-8 of the specification. Applicants respectfully submit that in the absence of a prima facie case

of obviousness set forth by the Examiner, rebuttal of the obviousness rejection is precluded.

Consideration of the prior art references cited in the Information Disclosure Statement is respectfully requested.

Entry of the foregoing amendments is respectfully requested inasmuch as the amendments place the application in condition for allowance.

In view of the foregoing remarks, it is respectfully urged that the rejections set forth in the September 4, 1998 Official Action be withdrawn and that this application be passed to issue and such action is earnestly solicited.

Respectfully submitted,

*Maureen P. O'Brien*

Maureen P. O'Brien, Ph.D., J.D.  
Attorney for Applicants  
Registration No. 42,043

DuPont Pharmaceuticals Company  
DuPont Legal Patent Records Center  
1007 Market Street  
Wilmington, DE 19898

CERTIFICATE OF MAILING (37 C.F.R. §1.8(a))

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Assist. Commissioner of Patents and Trademarks, Washington, DC 20231, on this \_\_\_\_\_ day of \_\_\_\_\_.

\_\_\_\_\_/Cathleen M. Collins